

### **REMARKS/ARGUMENTS**

Claims 1-2, 8, 11-13, 16, 21, 24-26, 46-50 and 54-58 are pending. Reconsideration is respectfully requested.

#### **1. Attorney Docket Number**

Applicants request that the Attorney Docket Number be changed to: 2502000-991130.

#### **2. Rejection of Claims 1-2, 8, 11-13, 16, 21, 24-26, 46-50 and 54-58 Under § 112**

Claims 1-2, 8, 11-13, 16, 21, 24-26, 46-50 and 54-58 stand rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement because the phrase “at least one attachment point extending from the front side of said backing in a non-orthogonal manner” lacks support in the original disclosure.

The Applicants respectfully traverse this rejection. The non-orthogonal orientation of the attachment point relative to the backing is disclosed on page 24, lines 3-16, and is shown in various figures as originally filed. For example, this disclosure states:

“Attachment points may be canted in one direction (500), such as toward the center of the device as shown in Figure 5A. The attachment points may also be variously oriented, such as toward center (502) and erect (504), or toward center (502) and away from center (506). It is within the scope of this invention to have attachment points extending in any relative direction or orientation on the backing.” (Page 24, lines 7-12)

Moreover, Figs. 2C, 4B, 5A-F and 6A-6B are just some examples of drawings as originally filed that clearly illustrate attachment points extending from the front side of the backing in a non-orthogonal manner.

Therefore, it is respectfully submitted that this rejection is erroneous and should be withdrawn.

**3. Rejection of Claims 1-2, 13, 16, 18, 21, 24-26 and 54 Under § 102(b)**

Claims 1-2, 13, 16, 18, 21, 24-26 and 54 stand rejected under 35 U.S.C. §102(b) as being anticipated by US Patent 5,352,229 (Goble). Claim 18 was previously cancelled.

Claim 1 as amended recites a supportive backing that combines the at least one through-hole, and the at least one attachment point extending from the front side of the backing in a non-orthogonal manner. In contrast, Goble discloses an arbor press staple and washer, which includes a flat plate 31, an opening 33 formed in the plate to allow threaded pin 24 to pass there-through, and a plurality of straight spikes 35/36 (Col. 5, line 55 to Col. 6, line 28; Fig. 2) that extend from the plate 31 in an orthogonal manner so that the direction of the spikes match their movement (the spikes engage the ligament by vertical movement of the plate 31 induced by threaded pin 24). See Col. 6, line 46 to Col. 7, line 4. Thus, Goble fails to anticipate claim 1. In fact, Goble teaches away from the claimed combination because angling the spikes of Goble would be incompatible with the vertical movement of plate 31 as threaded pin 24 is operated.

On page 2 of the Office Action, the Examiner asserts that Goble does teach attachment points extending from the backing in a non-orthogonal manner:

“The attachment point 35 extends from the backing 31 in a non-orthogonal manner, since the sides of the extension to which the attachment point 35 is connected to the backing 31 project from the backing 31 as an angle to the surface from which they extend. There is no 90° angle between the side of the extension to which the attachment point 35 is connected; on the contrary, the angle is approximately 45°, which would make the ‘at least one attachment point 35 extending from the front side of said backing 31 in a non-orthogonal manner.’”

The Examiner’s explanation relies on an “extension” to which the attachment point 35 is connected to the backing. Yet, no such extension is shown in the drawings, the term “extension” cannot be found in the Goble specification, and no such “extension” is claimed. If for some reason the Examiner maintains this rejection, it is respectfully requested that the “extension” relied upon be identified with better specificity.

If the Examiner is somehow construing “attachment point” as limited only to the very tip of the spike, the Applicants respectfully traverse this interpretation as contrary to the specification and the claims. The Applicants’ disclosure (against which the claims are construed) makes explicitly clear that “attachment points” are tines or prongs, and not just the very tip of such tines or prongs (see page 21, lines 5+). More importantly, claim 1 recites that the attachment point extends from the front side of the backing (in a non-orthogonal manner), not from any intermediary element such as an “extension” which is not claimed.

It must be noted that the Examiner’s conclusion is explicitly contradicted by the explicit teaching of Goble. The spikes 35 in Goble are clearly shown in the figures as extending from the bottom surface of plate 31 in an orthogonal manner (see Figs. 2, 4 and 5), and the Goble specification explicitly states that the spikes “extend at right angles” from the undersurface of the flat plate 31 (Col. 6, lines 13-17).

Therefore, it is respectfully submitted that claim 1 (and claims 2, 13, 16, 21, 24-26 and 54 dependent thereon), are not anticipated by Goble.

#### **4. Rejection of Claims 8, 11-12, 46-47 and 49 Under § 103(a)**

Claims 8, 11-12, 46-47 and 49 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Goble in view of US 4,548,202 (Duncan). The Applicants respectfully traverse this rejection.

Claims 8, 11-12, 46-47 and 49 all depend from claim 1, which is considered allowable for the reasons set forth in Part 3 above. The addition of Duncan fails to remedy the deficiencies of Goble.

Moreover, the text citations from Duncan relied upon by the Examiner regarding “facilitating healing”, “hemostatic compression”, and accommodating “varying tissue thicknesses” fail to teach or suggest flexibility, porosity, the use of mesh, net, or lattice, or intra-operative shaping as recited in these dependent claims. More importantly, one having ordinary skill in the art would not modify the device in Goble to make it flexible, make it porous, make it

out of mesh, net or lattice, or make it for intra-operative shaping as suggested by the Examiner, because the Goble device relies on the rigidity of plate 31 so that threaded pin 24 can drive plate 31 through the ligament and on the bone surface (Col. 6, lines 46+). A primary reference may not be modified in light of or combined with one or more secondary references where the result would be to render the primary reference inoperable for its intended purpose. In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Therefore, the Applicants respectfully traverse the conclusion that it would have been obvious to modify the Goble device as stated by the Examiner.

**5. Rejection of Claims 8, 46-47 and 49 Under § 103(a)**

Claims 8, 46-47 and 49 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Goble in view of US Patent 5,779,706 (Tschakaloff). The Applicants respectfully traverse this rejection.

Claims 8, 46-47 and 49 depend from claim 1, which is considered allowable for the reasons set forth in Part 3 above. The addition of Tschakaloff fails to remedy the deficiencies of Goble. Additionally, as stated above in Part 4, it would not have been obvious to modify the Goble device in a manner that would render it inoperative for its intended purpose.

**6. Rejection of Claims 48 and 50 Under § 103(a)**

Claims 48 and 50 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Goble. The Applicants respectfully traverse this rejection.

Claims 48 and 50 depend from claim 1, which is considered allowable for the reasons set forth in Part 3 above.

Moreover, claims 48 and 50 recite that the supportive backing front and back sides are curved or the back side is concave. The Examiner acknowledges that Goble fails to teach or suggest any such configuration of the backing. Instead, the Examiner premises this rejection on a general conclusion that it was well known to form implant devices in a curved configuration

and thus it would have been obvious to so modify the backing. Applicants respond first by respectfully stating deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalities. In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). Secondly, to the extent the Examiner is taking official notice of curved implant devices, and/or of the motivation to combine, the Applicants respectfully traverse, noting that MPEP §2144.03 states that while Examiners may take official notice of facts outside of the record, if the applicant traverses such an assertion, "the examiner should cite a reference in support of his or her position."

The Examiner also premises this rejection on a conclusion that the Applicants have not asserted that this specific configuration provides an advantage, solves a problem or serves a purpose different from a planar backing. To the contrary, page 52, lines 12-13 of the disclosure explicitly states that such devices are well suited for orbital reconstruction and suspensions where curves are desirable to accommodate facial bones.

Therefore, it is submitted claims 48 and 50 are not rendered obvious by Goble.

#### **7. Rejection of Claims 55-58 Under § 103(a)**

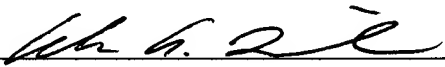
Claims 55-58 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Goble in view of US Patent 6,110,100 (Talpade). The Applicants respectfully traverse this rejection.

Claims 55-58 depend from claim 1, which is considered allowable for the reasons set forth in Part 3 above. The addition of Talpade fails to remedy the deficiencies of Goble.

For the foregoing reasons, it is respectfully submitted that the present application is in condition for allowance.

Respectfully submitted,

DLA PIPER RUDNICK GRAY CARY US LLP

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Alan A. Limbach  
Reg. No. 39,749

Attorneys for Applicant(s)

Alan A. Limbach  
DLA Piper Rudnick Gray Cary US LLP  
2000 University Avenue  
East Palo Alto, CA 94303-2248  
650-833-2433 (Direct)  
650-833-2000 (Main)  
650-833-2001 (Facsimile)  
alan.limbach@dlapiper.com